

Express Mail Label No.: EV942369808US
Date of Deposit: January 22, 2008

Attorney Docket No. 24852-501 CIP



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/600,132 Confirmation No.: 8627
Applicant : Thomas A. MILLER
Filed : June 19, 2003
TC/A.U. : 1621
Examiner : Yevgeny VALENROD
For : **POLYMORPHS OF SUBEROYLANILIDE
HYDROXAMIC ACID**

MAIL STOP PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)

Pursuant to the provisions of 37 C.F.R. §1.705, Applicants respectfully request patent term adjustment for this application as set forth in the paragraphs that follow. A check, No. 4252 in the amount of \$200.00 to cover the fee required under 37 C.F.R. §1.18(e) accompanies this Application.

Applicants received a Notice of Allowance and Fees Due from the U.S. Patent and Trademark Office (hereinafter "the Office"), mailed on December 12, 2007, which stated that the Patent Term Adjustment to date is 513 days. By this paper, Applicants hereby petition the Office for reconsideration of the patent term adjustment calculation to **615 days** based on the facts provided herein.

The facts in support of this filing are as follows:

The instant patent application was filed on June 19, 2003, and is therefore subject to the patent term adjustment procedures set forth in 37 C.F.R. §§1.702 to 1.705 for applications filed on or after May 29, 2000.

01/25/2008 TNGUYEN3 00000022 10600132

01 FC:1455

200.00 OP

On October 27, 2003, the Office mailed a Notice to File Missing Parts of Non-Provisional Application. The action set a two-month shortened statutory period for reply from the mailing date of the Notice.

On February 27, 2004, Applicants filed a Response to the Notice to File Missing Parts with a request for a two-month extension of time. As shown in the PAIR printout submitted herewith as Exhibit 1, the number of days of Patent Term Adjustment for Office delay is properly reduced by 31 days of applicant delay due to the non-timely submission of this Response.

On June 2, 2006, the Office mailed a Restriction Requirement. Applicants were properly granted 652 days of patent term adjustment due to Office delay pursuant to 37 C.F.R. §1.703(a)(1) for the time period between August 19, 2004 to June 2, 2006 (i.e., the number of days between the day after the date that is fourteen months after the June 19, 2003 filing date and the mailing of the Restriction Requirement).

On March 14, 2007, the Office mailed a Non-Final Office Action, setting a three-month statutory period for reply from the mailing date of the Office Action.

On July 16, 2007, Applicants filed a Response to the Non-Final Office Action with a request for a one-month extension of time. According to Exhibit 1, the Response was forwarded to the Examiner on July 30, 2007. The number of days of Patent Term Adjustment for Office delay is properly reduced by 32 days of applicant delay due to the non-timely submission of this Response.

On October 9, 2007, Examiner Valenrod called Applicant's representative, Michelle Iwamoto, indicating that he believed the subject matter of the claims to be novel and non-obvious, and requested authorization to file an Examiner's Amendment, amending the claims to recite "methanol, ethanol, or isopropanol" instead of "organic solvent." Examiner Valenrod requested that Applicants provide him with an answer by October 12, 2007.

On October 12, 2007, Applicants prepared and faxed a draft document for discussion purposes, containing proposed amendments to the claims for Examiner Valenrod's review, with the understanding that Examiner Valenrod would enter such claims by way of an Examiner's Amendment.

On October 19, 2007, Applicants telephonically interviewed Examiner Valenrod and Supervisory Patent Examiner (SPE) James O. Wilson to discuss the allowability of the claims sent on October 12, 2007. In view of the issues discussed in the interview, Applicants agreed to submit a Supplemental Amendment at the request of Examiner Valenrod, which incorporated Examiner Valenrod's additional suggested claim amendments.

On October 26, 2007, Applicants submitted the Supplemental Amendment at the request of Examiners Valenrod and Wilson. The Supplemental Amendment at pages 1 and 12 states that the Supplemental Amendment was in response to the telephonic interview of October 19, 2007 with Examiner Valenrod and his SPE. According to Exhibit 1, this Supplemental Amendment was forwarded to Examiner Valenrod on November 1, 2007. As shown in Exhibit 1, the number of days of Patent Term Adjustment for Office delay was reduced by 102 days, allegedly due to submission of a supplemental reply or other paper under 37 C.F.R. §1.704(c)(8). However, in view of the facts set forth above, Applicants contend that the submission of the Supplemental Amendment on October 26, 2007 was at the request of the Examiner. Thus, Applicants believe the number of days of Patent Term Adjustment for Office delay is improperly reduced by 102 days.

On December 10, 2007, Exhibit 1 indicates that the Notice of Allowance Data Verification was completed, and that an Examiner's Amendment was prepared. On December 12, 2007, the Office mailed a Notice of Allowance, an Examiner's Amendment, and a summary of a December 6, 2007 phone call between Examiner Valenrod and Ivor Elrifi.

Applicants were properly granted 26 days of patent term adjustment due to Office delay pursuant to 37 C.F.R. §1.703(a)(2) for the time period between November 16, 2007 and December 12, 2007 (i.e., the number of days between the day after the date that is four months after the July 16, 2007 Reply was filed and the mailing of the Notice of Allowance).

According to the provisions of 37 C.F.R. §1.702(b), Applicants are further entitled to Patent Term Adjustment for the failure of the Office to issue the patent within three years after the date on which the application was filed. Applicants are entitled to this adjustment because none of the provisions described in 37 C.F.R. §1.702(b)(1)-(5) apply in the instant application. The amount of the Adjustment will depend on the date that the instant application is issued as a patent and should be counted starting from June 19, 2006, subtracting only time legitimately attributable to applicant delay. In the instant case, applicant delay should be calculated as 63 days, which corresponds to the number of days attributed to the Response to the Notice to File Missing Parts filed on February 27, 2004, and the request for extension of time filed on July 16, 2007, but should not include as applicant delay the 102 days associated with the Supplemental Amendment of October 26, 2007 requested by the Examiner. Therefore, the number of additional days under 37 C.F.R. §1.703(b) to the extent that they do not overlap with periods calculated under 37 C.F.R. §1.703(a), (c), (d) and (e) should be added to the 615 total days of PTA.

In summary, Applicants respectfully request that the Patent Term Adjustment be increased from 513 days as reported on the Determination of Patent Term Adjustment under 35 U.S.C. §154(b) to 615 days. Applicants additionally request any further patent term adjustment based on the issue date of the patent as recalculated by the USPTO based on the issue notification.

If the Office would like to discuss any aspect of this filing, the Office representative assigned to process this request is welcome to contact the undersigned.

Express Mail Label No.: EV942369808US
Date of Deposit: January 22, 2008

Attorney Docket No. 24852-501 CIP

No additional fees are believed to be due by submission of this paper. However, the Office is authorized to charge such fee, or credit any overpayment in fees to Deposit Account No. **50-0311**, Customer Number **35437**, Attorney Docket No. **24852-501 CIP**.

Respectfully submitted,

Dated: January 22, 2008

Michelle A Iwamoto

Ivor R. Elrifi, Reg. No. 39,529
Michelle A. Iwamoto, Reg. No. 55,296
Attorneys/Agents for Applicants
c/o MINTZ, LEVIN, *et al.*
666 Third Avenue-24th Floor
New York, New York 10017
Telephone: (212) 935-3000
Telefax: (212) 983-3115

10/600,132 POLYMORPHS OF SUBEROYLANILIDE HYDROXAMIC ACID

01-22-
2008::10:58:06**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/600,132

Filing or 371(c) Date:	06-19-2003	USPTO Delay (PTO) Delay (days):	678
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	165
Post-Issue Petitions (days):	+0	Total PTA (days):	513
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
12-12-2007	Mail Notice of Allowance	26	
12-12-2007	Mail Examiner's Amendment	↑	
12-10-2007	Document Verification	↑	
12-10-2007	Examiner's Amendment Communication	↑	
12-10-2007	Notice of Allowance Data Verification Completed	↑	
12-10-2007	Case Docketed to Examiner in GAU	↑	
11-01-2007	Date Forwarded to Examiner	↑	
10-26-2007	Supplemental Response		102
04-18-2007	Information Disclosure Statement considered		↑
05-23-2007	Information Disclosure Statement considered		↑
07-19-2007	Information Disclosure Statement considered		↑
07-19-2007	Information Disclosure Statement (IDS) Filed		↑
07-16-2007	Rule 47 / 48 Correction of Inventorship Papers Filed		↑
07-30-2007	Date Forwarded to Examiner		↑
07-16-2007	Response after Non-Final Action		32
07-16-2007	Request for Extension of Time - Granted		↑
07-19-2007	Information Disclosure Statement (IDS) Filed		↑
05-23-2007	Reference capture on IDS		↑
05-23-2007	Information Disclosure Statement (IDS) Filed		↑
05-23-2007	Information Disclosure Statement (IDS) Filed		↑
07-25-2006	Information Disclosure Statement considered		↑
07-25-2006	Information Disclosure Statement (IDS) Filed		↑
04-18-2007	Reference capture on IDS		↑
04-18-2007	Information Disclosure Statement (IDS) Filed		↑
04-18-2007	Information Disclosure Statement (IDS) Filed		↑
03-14-2007	Mail Non-Final Rejection		↑
03-05-2007	Non-Final Rejection		
12-19-2006	Rule 47 / 48 Correction of Inventorship Papers Filed		
12-29-2006	Date Forwarded to Examiner		
12-11-2006	Response after Non-Final Action		
09-12-2006	Mail Non-Final Rejection		

09-05-2006	Non-Final Rejection		
04-06-2004	Information Disclosure Statement considered		
03-14-2005	Information Disclosure Statement considered		
10-05-2005	Information Disclosure Statement considered		
07-25-2006	Reference capture on IDS		
07-13-2006	Date Forwarded to Examiner		
06-29-2006	Response to Election / Restriction Filed		
06-02-2006	Mail Restriction Requirement	652	
05-30-2006	Requirement for Restriction / Election	↑	
03-13-2006	Case Docketed to Examiner in GAU	↑	
10-05-2005	Reference capture on IDS	↑	
10-05-2005	Information Disclosure Statement (IDS) Filed	↑	
10-05-2005	Information Disclosure Statement (IDS) Filed	↑	
09-02-2005	Case Docketed to Examiner in GAU	↑	
07-13-2005	Case Docketed to Examiner in GAU	↑	
03-14-2005	Reference capture on IDS	↑	
03-14-2005	Information Disclosure Statement (IDS) Filed	↑	
03-14-2005	Information Disclosure Statement (IDS) Filed	↑	
12-01-2004	Case Docketed to Examiner in GAU	↑	
07-23-2004	IFW TSS Processing by Tech Center Complete	↑	
07-23-2004	Case Docketed to Examiner in GAU	↑	
04-06-2004	Reference capture on IDS	↑	
04-06-2004	Information Disclosure Statement (IDS) Filed	↑	
04-06-2004	Information Disclosure Statement (IDS) Filed	↑	
12-22-2003	Preliminary Amendment	↑	
03-12-2004	Application Return from OIPE	↑	
03-12-2004	Application Return TO OIPE	↑	
03-12-2004	Application Dispatched from OIPE	↑	
03-12-2004	Application Is Now Complete	↑	
02-27-2004	Additional Application Filing Fees		31
02-27-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant	↑	
02-27-2004	Applicant has submitted new drawings to correct Corrected Papers problems	↑	
10-27-2003	Notice Mailed--Application Incomplete--Filing Date Assigned	↑	
08-12-2003	Cleared by OIPE CSR		
07-15-2003	IFW Scan & PACR Auto Security Review		
06-19-2003	Initial Exam Team nn		

[Close Window](#)